

REMARKS

The present application was filed on September 27, 1999 with claims 1-15. Claims 1-15 were canceled and claims 16-32 were added in an amendment filed on July 11, 2003. Claims 16-32 remain pending. Claims 16, 31 and 32 are the pending independent claims.

In the outstanding Office Action dated March 25, 2004, the Examiner: (i) rejected claims 16, 18, 20, 26, 31 and 32 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,659,742 to Beattie et al. (hereinafter "Beattie"); (ii) rejected claims 17, 25, 29 and 30 under 35 U.S.C. §103(a) as being unpatentable over Beattie in view of U.S. Patent No. 6,424,979 to Livingston et al. (hereinafter "Livingston"); (iii) rejected claim 23 under 35 U.S.C. §103(a) as being unpatentable over Beattie in view of U.S. Patent No. 6,438,543 to Kazi et al. (hereinafter "Kazi"); and (iv) rejected claim 21 under 35 U.S.C. §103(a) as being unpatentable over Beattie in view of U.S. Patent No. 6,243,713 to Nelson et al. (hereinafter "Nelson").

Applicants acknowledge the indication of allowable subject matter in claim 28. Claims 19, 22, 24 and 27 were not addressed in the Office Action.

With regard to the rejection of claims 16, 18, 20, 26, 31 and 32 under 35 U.S.C. §103(a) as being unpatentable over Beattie, Applicants respectfully assert that Beattie fails to establish a prima facie case of obviousness under 35 U.S.C. §103(a).

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and that "this precedent has been reinforced in myriad decisions, and cannot be dispensed with." In re Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that "conclusory statements" by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved "on subjective belief and unknown authority." Id. at 1343-1344.

In the Office Action at page 4, the Examiner provides the following statements to prove motivation to modify Beattie, with emphasis supplied: "it would have been obvious to one of ordinary skill in the art at the time of the invention to interpret the text module as a query since it is simply identifying text in data which is what a query does as well."

Applicants submit that these statements are based on the type of “subjective belief and unknown authority” that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, the Examiner fails to identify any objective evidence of record which supports the proposed modification.

Beattie discloses a method for storing information in an information retrieval system having a database for retrieval of input information in response to a query.

Independent claims 16, 31 and 32 of the claimed invention recite techniques for creating a dynamic representation from data received from an information source. Data received from the information source is stored and at least one text instance is identified in the data using a text processing module. An image is found in an image database module that relates to the text instance, and the dynamic representation of the data is generated from the image and the data.

The Office Action states that it is well known to match an image to a particular text instance for publication of dynamic information. Applicants assert that, assuming *arguendo* that it is well known to match an image to a particular text in general, it is not obvious to find an image in an image database module relating to a text instance in the data identified by a text processing module, for generating a dynamic representation of the data, as described in the claimed invention. Applicants assert that other distinctions exist as well.

Beattie fails to disclose the creation of a dynamic representation from data received from an information source as described in the independent claims of the present invention. More specifically, Beattie fails to disclose the storing of data received from an information source and the identification of at least one text instance in the data using a text processing module.

The Examiner contends that Beattie teaches a query that returns multimedia results for display on a display system, and the query module is in essence acting as the text processing module. However, the query as described in Beattie is not analogous to the text processing module as described in the present invention since the text processing module identifies text instances in the stored data used to create the dynamic representation. The query is a search performed to find the data and images to be stored and which may be displayed, while the text processing module of the present invention identifies text instances in data that has been already been stored and will be the

basis for the dynamic representation. It is impossible for the query to identify text instances in stored data for a representation when the data itself has not yet been identified. Therefore, Beattie fails to disclose a text processing module that identifies text instances in the data for creating a dynamic representation, as well as an image database module that finds an image relating to the text instance identified by the text processing module.

In more general terms, the techniques of Beattie begin with a query to retrieve data and images, while the techniques of the present invention begin with data that will be dynamically represented by identifying text instances in the data and finding corresponding images.

For at least the above reasons, Applicants submit that independent claims 16, 31 and 32 are patentable over the cited reference. Applicants submit that claims 18, 20 and 26 are patentable over the cited reference not only due to their respective dependence on claims 16, 31 and 32, but also because such claims recite patentable subject matter in their own right. Accordingly, withdrawal of the rejection to claims 16, 18, 20, 26, 31 and 32 under 35 U.S.C. §103(a) is therefore respectfully requested.

With regard to the rejection of claims 17, 25, 29 and 30 under 35 U.S.C. §103(a) as being unpatentable over Beattie in view of Livingston, Applicants assert that such claims are patentable for at least the reasons that independent claim 16, from which claims 17, 25, 29 and 30 depend, is patentable. The patentability of claim 16 is discussed above. Applicants submit that claims 17, 25, 29 and 30 are patentable over the cited references not only due to their respective dependence on claim 16, but also because such claims recite patentable subject matter in their own right. Accordingly, withdrawal of the rejection to claims 17, 25, 29 and 30 under 35 U.S.C. §103(a) is therefore respectfully requested.

With regard to the rejection of claim 23 under 35 U.S.C. §103(a) as being unpatentable over Beattie in view of Kazi, Applicants assert that such claim is patentable for at least the reasons that independent claim 16, from which claim 23 depends, is patentable. The patentability of claim 16 is discussed above. Applicants submit that claim 23 is patentable over the cited references not only due to its dependence on claim 16, but also because such claim recites patentable subject matter in its own right. Further, Applicants point out that the Continued Prosecution Application (CPA) status

of this application precludes the use of Kazi as a reference under 35 U.S.C. §103(c). Accordingly, withdrawal of the rejection to claim 23 under 35 U.S.C. §103(a) is therefore respectfully requested.

With regard to the rejection of claim 21 under 35 U.S.C. §103(a) as being unpatentable over Beattie in view of Nelson, Applicants assert that such claim is patentable for at least the reasons that independent claim 16, from which claim 21 depends, is patentable. The patentability of claim 16 is discussed above. Applicants submit that claim 21 is patentable over the cited references not only due to its dependence on claim 16, but also because such claim recites patentable subject matter in its own right. Accordingly, withdrawal of the rejection to claim 21 under 35 U.S.C. §103(a) is therefore respectfully requested.

In view of the above, Applicants believe that claims 16-32 are in condition for allowance, and respectfully request favorable consideration.

Respectfully submitted,



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